

Amendment After Final Rejection Under 37 CFR 1.116
Application No. 10/684,858
Docket No. 012003-03

REMARKS/ARGUMENTS

The Office Action mailed on October 20, 2004 has been studied. The allowance of claims 20-22, 26-29, 32-35 and 37 is noted and is appreciated. It is proposed to cancel claims 1, 24 and 25 from the application, make claims 3-19 ultimately dependent on allowed claim 37, and incorporate the limitation of cancelled dependent claim 25 into independent claim 23. It is believed that these proposed amendments place the application in condition for allowance and therefore reconsideration of the application is respectfully requested.

The Drawing Objection

The drawings were objected to under 37 CFR 1.83(a) on the grounds that they must show every feature of the invention specified in the claims. In support of this objection, the Examiner argues that the "device must be devoid of wave shapers, deflectors, inner cases and mechanical insert" and contends that reference element 14 in Applicants' drawings is such a device. Although Applicants disagree with the Examiner's characterization of element 14, they have cancelled claim 24, which requires the absence of wave shapers, deflectors, inner cases and mechanical inserts, from the application. Since there are no remaining claims that recite the absence of such elements, this amendment should overcome the Examiner's objection and obviate the need to submit corrected drawings.

The 35 USC 102 Rejection

Claims 23 and 24 in the application were rejected under 35 USC 102(b) as being anticipated by Bucklishch (U.S. Patent 3,736,875). Although, Applicants disagree with the Examiner's rejection, they propose to cancel claim 24 from the application and to incorporate the substance of dependent claim 25 into independent claim 23. Since the Examiner indicates at the bottom of page 5 of the Office Action that

claim 25 would be allowable if rewritten in independent form including the limitations of any intervening claims, independent claim 23, which now contains the limitation of claim 25, should be allowable.

The 35 USC 103 Rejections

Claims 1 and 19 were rejected under 35 USC 103(a) as being unpatentable over Bucklishch in view of Yates, Jr. (U.S. Patent 4,829,901). Claim 1 has been cancelled from the application, and claim 19 has been made dependent on allowed claim 37. Thus, this rejection should now be overcome.

Claims 30 and 31 in the application were rejected under 35 USC 103(a) as being unpatentable over Bucklishch in view of Kash (U.S. Application No. 2004/0107825). Claims 30 and 31 in the application are drawn to perforating guns comprising a plurality of the shaped charge perforators of claim 23. Since claim 23 has been amended by incorporating the limitation of claim 25, which claim the Examiner has indicated contains allowable subject matter, claims 30 and 31 should now be allowable.

Dependent Claims 3-18 and 36

At the bottom of page 5 of the Office Action, the Examiner indicates that claims 3-18 and 36 would be allowable if rewritten in independent form. These claims previously depended from independent claim 1. It is proposed to make these claims ultimately depend from allowed independent claim 37 by amending claim 3 to depend directly from allowed claim 37 instead of rejected claim 1. These amendments should render claims 3-18 and 36 allowable. The amendment to claim 13 is necessary to make its language consistent with that of claim 37.

The Finality of the Rejection

On page 6 of the Office Action, the Examiner makes this action final. However, it is respectfully submitted that the action can not be made final under the rules of MPEP 706.07(a). This section states that a second or subsequent action on the merits shall be final "except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." In the first substantive Office Action mailed June 28, 2004, the Examiner rejected claim 1 under 35 USC 102(b) over Bucklishch. In responding to this rejection, the Applicants argued without amending the claim that this rejection was unwarranted. In the current Office Action, the Examiner rejects claim 1 under 35 USC 103(a) over Bucklishch in view of Yates, Jr. This is a new ground of rejection that was not necessitated by an amendment nor based on information submitted in an information disclosure statement (IDS) filed under 37 CFR 1.97(c). Although the Yates, Jr. patent was cited by Applicants in an IDS, this IDS was submitted with the application under 37 CFR 1.97(b)(1) and not during the period set forth in 37 CFR 1.97(c). Thus, the finality of this action is premature and should be withdrawn.

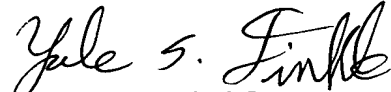
Conclusion

In view of the foregoing, it is submitted that the now-pending claims are in condition for allowance. Thus, it is respectfully requested that the Examiner enter the proposed amendments, withdraw the final rejection, and pass the case to

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issue. Even if the Examiner does not feel that the case is in condition for allowance, the amendments should be entered because the Office Action was prematurely made final.

Respectfully submitted,



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